

**REMARKS**

Applicants timely submit this Response and Request for Reconsideration to the Examiner's Office Action of August 18, 2009. Applicants have carefully reviewed the Office Action and the following remarks are made in response thereto. In view of the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

**I. Summary of the Office Action**

1. Claims 1, 2, 5, 6, and 21-26 are pending in the application.
2. Claims 1, 2, and 21-25 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over JAETSCH (U.S. 2001/0027217; Published Oct. 4, 2001; cited in Office Action dated Jun. 19, 2008) in view of ESSINGER (U.S. 5,665,678; Issued Sep. 9, 1997) and KIRBY (WO 99/18787; Published Apr. 22, 1999).
3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Jaetsch in view of Essinger, Kirby, as applied to claims 1, 2, and 21-25 above, and further in view of BUSCHHAUS (WO 98/18328; Published May 7, 1998; 5th reference cited on IDS dated Jun. 2, 2005).
4. Claim 26 is rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Jaetsch in view of Essinger, Kirby, as applied to claims 1, 2, and 21-25 above, and further in view of ISATO (JP

8039511; Feb. 2, 1996; 1st reference cited on IDS dated Jun. 2, 2005; translation previously provided).

5. Claims 1, 2, 6, 21, 24, and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 11, 14, 15, and 22 of copending Application No. 10/537,192 in view of in view of Jaetsch, Essinger, Kirby, and

## **II. Response to the Office Action**

### **1. Claim Rejections under 35 U.S.C. §103(a)**

#### **A. Jaetsch in view of Essinger and Kirby**

Claims 1, 2, and 21-25 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over JAETSCH (U.S. 2001/0027217; Published Oct. 4, 2001; cited in Office Action dated Jun. 19, 2008) in view of ESSINGER (U.S. 5,665,678; Issued Sep. 9, 1997) and KIRBY (WO 99/18787; Published Apr. 22, 1999).

Jaetsch discloses adhesive formulations for production of wooden material or wood composites containing monophenolic compounds and other anti-insect, anti-basidiomycetes, anti-termite and anti-fungal agents. (See Abstract, [0009] and [0011] of Jaetsch).

Although bifenthrin is exemplified as an anti-insect and anti-termite agent in the disclosed formulations ([0027] of Jaetsch), Jaetsch does not contemplate, suggest or teach that bifenthrin is particulated or bifenthrin has a mean particle size of 1-10  $\mu\text{m}$ .

In fact, as the Examiner acknowledges on page 4 of the Office Action, Jaetsch is completely silent with respect to the particle size of bifenthrin in the adhesive formulation. This is because the biocides in Jaetsch are dissolved in solvent - they are not particulate. As the examiner points out on page 4 of the Office Action, Jaetsch recognized a problem with prior formulations and stated that a “difficult problem occasionally occurs that much higher rates of the chemical formulation is need [sic] to be incorporated in the adhesive to attain the originally expected efficacy because the chemical often cannot disperse enough to achieve sufficient efficacy because of clathration of the chemical in the adhesive.” See Jaetsch at [0005].

To remedy this problem, Jaetsch specifically states at paragraph [0008] that “[t]he invention aims to supply the technique by which the disadvantages of the above mentioned existing technique can be *dissolved*.” [emphasis added].

Thus, Jaetsch teaches away from particulate bifenthrin having *any* size range because Jaetsch’s goal was to dissolve the chemical agents used in the formulations using solvents. Jaetsch specifically avoids the use of particulates.

The formulations of the Examples of Jaetsch for example, include 3% imidacloprid in 62% solvent ([0038]: Example of execution 1; [0050]: Example of comparison 1), 10% thiabendazole in 80% solvent ([0052]: Example of execution 2; [0055]: Example of comparison 2), 25% chlorpyrifos in 35% or 45% solvent ([0063]: Example of execution 3; [0066]: Example of comparison 3), 30% chlorpyrifos in 70% solvent ([0071]: Example of comparison 4; [0075]: Example of execution 4), 5% bifenthrin in 90% solvent ([0078]: Example of execution 5; [0081]: Example of comparison 5). Example of execution 5 and Example of comparison 5 disclose that

bifenthrin is applied as the mixing solution in treating the backside of plywood. ([0078] and [0081] of Jaetsch).

In each example, including the bifenthrin of Example 5, the biocide is dissolved in a solvent and is not particulate bifenthrin, let alone a bifenthrin with a mean particle size of 1-10  $\mu\text{m}$ .

The Examiner states, however, that "one would have strong motivation to identify the appropriate particle size since Jaetsch notes the prior art problems of dispersability, and correlates dispersibility with efficacy of the insecticide-containing adhesive."

Applicants disagree. A person of ordinary skill in the art, reading Jaetsch, would have had absolutely no motivation to modify the express teaching of Jaetsch and use particulate bifenthrin having a size range of 1-10  $\mu\text{m}$  because Jaetsch recognized that there are problems associated with using particulates and expressly avoided using particulates. Jaetsch solved the problem by using dissolved actives.

In spite of this, the Examiner alleges that Essinger cures the deficiencies of Jaetsch.

Essenger is directed to wettable powders (WP), water-dispersible granules (WG) and suspension concentrates (SC) of agriculturally acceptable formulations. The claims of the instant invention, however, are directed to glues for controlling pests that attack wood or wood products comprising a resin and bifenthrin, wherein the bifenthrin has a mean particle size of 1-10  $\mu\text{m}$ . Essinger makes no mention of glues or resins. Nothing in Essinger would have motivated a person having ordinary skill in the art to modify Jaetsch to arrive at the claimed invention as alleged by the Examiner. Applicants

respectfully submit that combining Jaetsch and Essinger to arrive at the claimed invention amounts to improper hindsight reconstruction of applicants' invention and ignores the express teaching away in Jaetsch.

The Examiner also uses Kirby to cure the deficiencies in Jaetsch.

Kirby is directed to methods of dispersing an insoluble material in aqueous solution and agricultural formulations. The disclosure is directed to dispersants for use in agricultural applications (see lines 1-8 of page 1). The claims of the instant invention, however, are directed to glues for controlling pests that attack wood or wood products comprising a resin and bifenthrin, wherein the bifenthrin has a mean particle size of 1-10  $\mu\text{m}$ . Kirby makes no mention of glues or resins. Nothing in Kirby would have motivated a person having ordinary skill in the art to modify Jaetsch to arrive at the claimed invention as alleged by the Examiner. Applicants respectfully submit that combining Kirby with Essinger and Jaetsch to arrive at the claimed invention amounts to improper hindsight reconstruction of applicants' invention and ignores the express teaching away in Jaetsch.

Withdrawal of the rejection is requested.

**B. Jaetsch in view of Essinger, Kirby and Buschhaus**

Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Jaetsch in view of Essinger, Kirby, as applied to claims 1, 2, and 21-25 above, and further in view of BUSCHHAUS (WO 98/18328; Published May 7, 1998; 5th reference cited on IDS dated Jun. 2, 2005).

Applicants' comments above with respect to Jaetsch, Essinger and Kirby are repeated and incorporated herein by reference.

Nothing in Buschhaus cures the deficiencies cited above.

Buschhaus teaches mixtures of binders or adhesives which can be used in the manufacture of plywood and timber materials with the compounds of the general formula (I) specified in Buschhaus (page 1, lines 21-25 of Buschhaus). Further, Buschhaus discloses that glues and adhesives are used as binders and biocides such as insecticide and fungicide can be incorporated into the bonding agent. (page 8, lines 7-19 of Buschhaus).

As the Examiner has previously acknowledged in the Office Action mailed June 19, 2008, Buschhaus does not disclose bifenthrin as an insecticide that can be mixed with binders or adhesives and Buschhaus does not disclose any particle sizes of insecticide or fungicide in the mixtures of binder or adhesives (See Office Action dated June 19, 2008 at page 5). Therefore, Buschhaus does not contemplate, suggest or teach particulate bifenthrin with a mean particle size of 1-10  $\mu\text{m}$  and does not cure the deficiencies of any of the other cited references.

Withdrawal of the rejection is requested.

**C. Jaetsch in view of Essinger, Kirby and Isato**

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaetsch in view of Essinger, Kirby, as applied to claims 1, 2, and 21-25 above, and further in view of ISATO (JP 8039511; Feb. 2, 1996; 1st reference cited on IDS dated Jun. 2, 2005; translation previously provided).

Applicants' comments above with respect to Jaetsch, Essinger and Kirby are repeated and incorporated herein by reference.

Nothing in Isato cures the deficiencies cited above.

Isato does not disclose or suggest particulate bifenthrin or that the disclosed bifenthrin has a mean particle size of 1-10  $\mu\text{m}$ . Isato is totally silent as to the particle sizes of pyrethroid, or particle sizes of bifenthrin to prevent termites.

Withdrawal of the rejection is requested.

#### **D. Double Patenting**

Claims 1, 2, 6, 21, 24, and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 11, 14, 15, and 22 of copending Application No. 10/537,192 in view of in view of Jaetsch, Essinger, Kirby.

Applicants request that the rejection under the judicially created doctrine of obviousness-type double patenting be held in abeyance until such time as an indication of allowable subject matter is made.

**III. Conclusion.**


Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 13-3250, Reference No. 38184.04013US. This paragraph is intended to be an **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with C.F.R. § 1.136(a)(3).

Respectfully submitted,  
**MILBANK, TWEED, HADLEY  
& McCLOY LLP**

Date: February 18, 2010

By:

  
Enrique Longton  
Registration No. 47,304

**Customer No. 000038647**  
**Milbank, Tweed, Hadley & McCloy LLP**  
International Square Building  
1850 K Street, N.W., Suite 1100  
Washington, D.C. 20006  
Telephone: (202) 835-7525  
Facsimile: (202) 263-1253